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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HISATO SHINOHARA and AKIRA SUGAWARA

Appeal 2009-015419
Application 08/169,127
Technology Center 1700

Before CHUNG K. PAK, TERRY J. OWENS, and JEFFREY T. SMITH, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

The Appellants request reconsideration of the affirmance of the rejection of claims 61-80, 91-94, 101, 104-107, 131 and 140-175 under the judicially created doctrine of obviousness-type double patenting over claims 1-30 of Shinohara in our Decision mailed July 29, 2010 (Request 1).

The Appellants argue that we improperly considered Shinohara's disclosed step of etching insulator 59 off of crystallized semiconductor islands 58 (col. 5, ll. 48-51, 59-61; col. 6, l. 11; Fig. 7B) (which corresponds to the Appellants' claim 61 recited step of "removing an insulating layer

comprising silicon oxide from an upper surface of the crystallized semiconductor layer") as being included in Shinohara's claim 1 step of "forming a plurality of thin film transistors using the crystallized semiconductor film as at least channel regions of the thin film transistors" (Request 6). The Appellants argue that if Shinohara's claim is interpreted in that manner, then the Appellants' "forming" step, which is described in a specification which Shinohara and the Appellants have in common, likewise should be interpreted as including the recited "removing" step, thereby rendering the recited "removing" step superfluous. *See id.*

"[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1256 (Fed. Cir. 2007), quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). The broadest reasonable interpretation consistent with the specification of the Appellants' claim 61 limitation "forming a plurality of thin film transistors" does not include the step of "removing an insulating layer comprising silicon oxide from an upper surface of the crystallized semiconductor layer" because that step is positively recited in the claim. The broadest reasonable interpretation of Shinohara's "forming a plurality of thin film transistors" claim limitation consistent with Shinohara's specification, which is the same as the Appellants' specification, includes the steps disclosed as part of forming the plurality of thin film transistors (col. 5, ll. 48-51, 59-61; col. 6, ll. 11-23; Fig. 7B) but not recited in Shinohara's claim 1, such as the step of etching off insulator layer 59 (which corresponds to the Appellants' claim 61 recited step of "removing an insulating layer comprising silicon oxide from an upper surface of the crystallized semiconductor layer").

Thus, the difference between the Appellants' claim 61 and Shinohara's claim 1 is that the Appellants' claim 61 positively recites the "removing" step, whereas that step is subsumed in Shinohara's claim 1 term "forming a plurality of tin film transistors". If the Appellants' application issued as a patent without a terminal disclaimer, then it and the Shinohara patent could be sold to different parties, thereby subjecting someone who performs the Appellants' "removing an insulating layer" step, which is subsumed in Shinohara's "forming a plurality of thin film transistors" step, to lawsuits by different parties for the same infringing act. Preventing such multiple lawsuits for the same infringing act is one of the functions served by the doctrine of obviousness-type double patenting and terminal disclaimers. *See* Form PTO/SB/26 (01-08), *Terminal Disclaimer to Obviate a Double Patenting Rejection over a "Prior" Patent*, in *Manual of Patent Examining Procedure* § 1490 (8th ed., Rev. 7, July 2008) ("The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.")

The Appellants argue, in reliance upon *In re Vogel*, 422 F.2d 438 (CCPA 1970), that the use of a patent's specification in an obviousness-type double patenting rejection is limited to determining the meaning of a word in a claim (Request 2-4).

The Court in *Vogel* stated that "in certain instances it [a patent's disclosure] may be used as a dictionary to learn the meaning of terms in a claim." *Vogel*, 422 F.2d at 441. Although the terms in *Vogel* were

individual words, such as "meat" and "pork", *see Vogel*, 422 F.2d at 442, *Vogel* does not limit the terms whose meanings are learned to individual words.[1] Also, the Court stated:

> The disclosure, however, sets forth at least one tangible embodiment within the claim, and it is less difficult and more meaningful to judge whether that thing has been modified in an obvious manner. It must be noted that this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. § 103, since only the disclosure of the invention claimed in the patent may be examined.

Vogel, 422 F.2d at 422. In accord with *Vogel*, in determining the meaning of Shinohara's claim term "forming a plurality of thin film transistors" we relied only upon an examination of the disclosure of Shinohara's claimed invention (Decision 8).

The Appellants argue that it was improper for the Board to interpret Shinohara as disclosing a silicon oxide insulator 59 when Shinohara discloses that insulator 59 can be silicon oxide or silicon nitride (col. 5, ll. 46-47) (Request 5-6).

Shinohara's disclosure that insulator 59 can be silicon nitride does not take away the disclosure of a silicon oxide insulator 59.

Regarding other groups of the Appellants' claims, i.e., claims 140, 153 and 164, claims 71, 76, 164 and 165 and claims 141 and 154, the Appellants provide arguments similar to those set forth with respect to claim 61 that we improperly used Shinohara's specification in construing Shinohara's claims (Request 6-9).

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[1] The relevant meaning of "term" is "a word or expression that has a precise meaning in some uses or is peculiar to a science, art, profession, or subject <legal ~ s>". *Webster's New Collegiate Dictionary* 1203 (G. & C. Merriam 1973). Thus, "term" is not limited to individual words.

Those groups of claims were addressed in our Decision (Decision 9-10). Our use of Shinohara's specification in interpreting Shinohara's claims was proper for the reasons set forth above with respect to the Appellants' claim 61.[2]

DECISION/ORDER

We have considered the Appellants' Request for Rehearing, but for the above reasons we decline to make any change to our Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED

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[2] The Appellants argue that there is no limitation in Shinohara's claims corresponding to the Appellants' peripheral circuit in claims 71, 76, 164 and 165 (Request 7-8). One of ordinary skill in the art would have interpreted Shinohara's claim term "driving circuit" in claim 61 as including a peripheral circuit, i.e., a circuit in a peripheral area (other semiconductor islands on the same substrate) in view of Shinohara's disclosure that other semiconductor islands on the same substrate can include a peripheral circuit for driving the pixel TFTs (col. 5, ll. 55-58),